



IFW

PATENT
Customer No. 22,852
Attorney Docket No. 6478.1505-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Norbert HEIMBURGER et al.) Group Art Unit: 1651
)
Application No.: 10/568,687) Examiner: T. Kim
)
Filed: February 17, 2006) Confirmation No.: 2787
)
For: C1-INH AS A DRUG FOR)
TREATING VIRUSES)
PATHOGENIC TO HUMANS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Applicants now reply to the Restriction Requirement dated September 19, 2006 ("Restriction Requirement"). The Examiner required restriction under 35 U.S.C. §§ 121 and 372 between the following groups of claims:

Group 1: Claims 7-22, relating to methods of treating an infection or modulating an immune response comprising administering to a subject an effective amount of a composition comprising C1 esterase inhibitor;

Group 2: Claims 23-34, relating to methods of detecting or isolating a virus or a bacterium using C1 esterase inhibitor; and

Group 3: Claim 35, relating to a composition for treating a viral or bacterial infection comprising C1 esterase inhibitor and antibodies against the virus or bacterium.

With regard to Groups 1 and 2, the Examiner has further divided these groups into alleged “species” of orthomyxoviruses, paramyxoviruses, and rotaviruses. Within the “species” of orthomyxoviruses, the Examiner has further designated influenza A and influenza B viruses as subspecies. Within the “species” of paramyxoviruses, the Examiner has further designated parainfluenza, mumps virus, and measles virus as subspecies.

Solely to facilitate prosecution and without prejudice or disclaimer, Applicants provisionally elect to prosecute Group 1, claims 7-22. Moreover, with respect to claims 7-22, Applicants also elect the alleged “species” orthomyxovirus and the alleged “subspecies” influenza A. Applicants make these elections with traverse for the reasons set forth below.

First, as the M.P.E.P. provides, “[i]f the search and examination of the entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803, emphasis added. There can be no serious burden to search all the claims because all the claims share a common aspect in that they all relate to C1 esterase inhibitor (C1-INH). Thus, all the claims should be examined to avoid unnecessary delay and duplicative examination.

Second, the Examiner asserts that Groups 1, 2, and 3 are to a product and methods of using that product. Restriction Requirement at page 3. To clarify the

record, Applicants note that none of the method claims of Groups 1 and 2 are dependent on claim 35. Thus, these methods are not limited to the use of a composition comprising C1-INH and antibodies against a virus or bacterium. Applicants respectfully contend, however, that the Examiner overlooked the fact that literature searches are generally based on key words. Accordingly, literature searches for methods of using a given protein and compositions comprising that protein are coextensive. Thus, Groups 1-3 are searchable together without serious burden because they reflect various embodiments of C1-INH.

The Examiner noted that the common technical feature of the claims in Groups 1 and 3 is C1-INH. Restriction Requirement at page 4. According to the Examiner, no special technical feature unites the claims in these groups because C1-INH is allegedly known in the art. *Id.* Regardless of whether or not C1-INH is known in the art, the claims in Groups 1-3 all share the technical feature of C1-INH. As discussed above, this relationship between the claims allows the Examiner to search them without undue burden.

Finally, the alleged “species” of group A at page 5 of the Restriction Requirement should, at the least, be remerged and searched together as a single group because they are all viruses. Applicants contend that the Examiner would perform a search based on C1-INH and viruses in general in order to examine claims 7, 16, 23, and 30. The results of such a search could be applied to dependent claims to specific virus families. If the Examiner does not agree with Applicants that the “species” of group A should be merged, then the “species” listed in groups B and C should at least be merged. The viral families of *Orthomyxoviridae* and *Paramyxoviridae* are relatively

small. In the family of *Orthomyxoviridae* , there is just one genus: Influenzavirus. In the family of *Paramyxoviridae* , there are only three genres: paramyxovirus, morbillivirus, and pneumovirus. Both parainfluenza and mumps virus are in the paramyxovirus genus while measles virus is in the morbillivirus genus. Thus, due to the small number of members in each family, the Examiner would not be presented with an undue burden in searching either one.


For the reasons provided above, Applicants therefore request that the Office rescind its restriction requirement and examine all pending claims 7-35. At the very least, the alleged "species" of groups B and C should be remerged into their respective virus families.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 19, 2006

By: 

Maryann T. Puglielli
Reg. No. 52,138